

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/631,583 Confirmation No. : 9242  
Applicants : Liwerant et al.  
Filed : August 3, 2000  
Title : **Method and System for Sharing Video with  
Advertisements Over a Network**  
Group Art Unit : 2623  
Examiner : Dominic D. SALTARELLI  
Customer No. : 28289

**MAIL STOP APPEAL BRIEF – PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANT'S BRIEF UNDER 37 C.F.R. § 41.37**

Sir:

The present Appeal Brief is submitted in support of the Notice of Appeal filed October 9, 2009. This Appeal Brief is timely filed without any petitions, as it is filed within two months from that date of filing the Notice of Appeal. The headings used hereinafter and that which is set forth under each heading are in accordance with 37 C.F.R. § 41.37(c)(1).

I hereby certify that this correspondence is being electronically submitted to the United States Patent and Trademark Office on October 30, 2009.	
_____ Lisa A. Miller (Name of Person Submitting Paper)	
Signature	10/30/2009 Date

## **I. REAL PARTY IN INTEREST**

The real party in interest for the application in this Appeal is the recorded Assignee, namely, Gad Liwerant (hereinafter, "Appellant"), who is also one of the inventors.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no appeals or interferences known to the Appellant or the Appellant's legal representative, which will directly affect, or be directly affected by or having a bearing on, a decision in the present Appeal.

## **III. STATUS OF CLAIMS**

Claims 13-35 have been cancelled. Claims 1-12 and 36-40, having all been rejected twice, and are pending in the present application. Only independent claims 1 and 36 are the subject of this Appeal.

Claims 1 and 36 stand rejected under 35 U.S.C. §103(a) for obviousness based upon U.S. Pat. Appl. Pub. No. 2001/0047294 to Rothschild (hereinafter "the Rothschild publication") in view of non-patent literature "Streaming Email" and further in view of U.S. Patent No. 6,236,395 to Sezan et al. (hereinafter "the Sezan patent").

## **IV. STATUS OF AMENDMENTS**

No amendments are being made or have been made to the claims after the Final Office Action dated April 10, 2009. Section VIII, below references the attached Claims Appendix which lists the currently pending claims.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

Generally, the present invention is directed to a method for sharing a video segment and an advertisement associated with that video segment over a network. The video segment is sent in a streaming format over the network along with the associated

advertisement to a receiving computer, so that both the video and the associated advertising segment may be viewed at the receiving computer.

For purposes of this Appeal, Appellant's representative invention is set forth as a method in claims 1 and 36. Reference to the underlying support for each of these claims is made with respect to the text of the originally filed application.

Claim 1 recites a method of sending a video segment and an associated advertisement over a computer network (*See* Summary of the Invention, in general), comprising: (a) acquiring a video segment and a still image in the form of a thumbnail from a sender at a computer system (*See* page 33, lines 12-15); (b) acquiring one or more advertisements from one or more advertisers at the computer system (*See* page 14, lines 15-19); (c) offering to the sender an opportunity to indicate a selection of an advertisement of the one or more advertisements to be associated with the video segment (*See* page 15, lines 3-8); (d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment; (*See* page 5, lines 5-9; page 16, lines 1-2) and (e) directly in response to the indication accepted in step (d), automatically at the computer system: (i) assuring that the video segment is in a streaming video format (*See* page 16, lines 4-5); (ii) creating an identifier for the video segment (*See* page 16, lines 5-6), wherein the identifier includes the still image and a link to the video (*See* page 21, line 21 to page 22, line 1; page 2, line 20 to page 3, line 2); (iii) associating the video segment and the advertisement; and (iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer (*See* page 16, lines 6-9).

Claim 36 recites a method for operating a video-sharing server on a network comprising (*See* Summary of the Invention, in general): storing a plurality of advertisements from one or more advertisers (*See* page 14, lines 15-19); receiving from a client a video, a still image in the form of a thumbnail (*See* page 33, lines 12-15), an electronic mail address (*See* page 44, lines 17-19), and a selection of one of the plurality of advertisements (*See* page 30, lines 11-13); confirming that the video is in a streaming video format (*See* page 31, lines 13-15); storing the video at a network-accessible location (*See* page 11, line 20 to page 12, line 2; page 22, line 15-18); generating an identification tag including a link and the still image to the network accessible location (*See* page 19, lines 5-16); generating an electronic communication containing the identification tag and the selected one of the plurality of

advertisements, the electronic communication addressed to the electronic mail address; and transmitting the electronic communication (*See* page 14, lines 2-10, lines 15-20).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

*Are claims 1 and 36 rendered obvious under 35 U.S.C. §103 by U.S. Pat. Appl. Pub. No. 2001/0047294 to Rothschild in view of non-patent literature "Streaming Email" and further in view of U.S. Patent No. 6,236,395 to Sezan et al.?*

## **VII. ARGUMENT**

The final Office Action dated April 10, 2009 (hereinafter "the final Office Action") fails to set forth a proper obviousness rejection with respect to claim 1 because: (i) the cited references taken alone or in combination fail to anticipate every limitation of claims 1 and 36, and (ii) the Examiner fails to take into consideration the teaching away arguments.

### **(i) lack of anticipation of all claimed limitations**

Independent claims 1 and 36 contain limitations directed to "assuring" or "confirming", respectively, that the video is in a streaming video format. The step of "assuring" or "confirming" indicates that a positive action is taken, namely, a *determination* made by analyzing a file to determine if in fact it is in a streaming video format. Although the prior art generally discloses the aspect of converting a file to a streaming video format, neither the Rothschild publication nor the Sezan patent references disclose this "assuring" or "confirming" claim limitation.

In the final Office Action, the Examiner cites *In re Van Geuns*, which stands for the proposition that "although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims." Appellant does not contest this principle, but rather the relevance thereof to the arguments made by Examiner. Specifically, the Examiner argues that "features upon which applicant relies (i.e., analyzing a file to determine if it is already in a streaming video format) are not recited in the rejected claims. However, it is set forth in the claims that the computer system is responsible for the

step of “assuring that the video segment is in a streaming video format.” Appellant’s description in its arguments to the non-final office action relating to “analyzing a file to determine if it is already in a streaming video format” was simply for purposes of clarifying to the Examiner what is meant by the claimed “assuring” or “confirming” step, if for some reason claim language was not sufficiently clear. Accordingly, Appellant agrees that the clarification is not to be read into the claims. However, the affirmative claimed steps of “assuring that the video segment is in a streaming video format” (claim 1) and “confirming that the video is in a streaming video format” are a part of the claim and are not disclosed in the Rothschild publication or the Sezan patent.

In the final Office Action, Examiner asserts that the “Streaming Email” publication on page 311 “teaches that the video being shared from the server is guaranteed to be in a streaming format upon sending the video.” Appellant argues that the “Streaming Email” publication only discloses the *creation* of a streaming video file, as opposed to the claimed “assuring” or “confirming” steps. Assuming, arguendo, that the “Streaming Email” publication does disclose the “assuring” or “confirming” aspects, claim 36 require that the “confirming” step be performed at the video-sharing server, as opposed to the personal computer (i.e., client) disclosed in the “Streaming Email” publication. The video-sharing server in claim 36 is claimed as receiving a video from a client, among other things, which therefore differentiates the video-sharing server from the client of the “Streaming Email” publication.

It is settled law that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 2 USPQ2d, 1051, 1053 (Fed. Cir. 1987). Based on the foregoing, none of the prior art of record discloses the aspect of “assuring” or “confirming” that a video is in a streaming video format.

(ii) *failure to take into consideration teaching away arguments*

Furthermore, the Examiner states that it would have been obvious to combine the method disclosed in the Rothschild publication with the aspect of “sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format,” as taught by the “Streaming Email” publication “for the

benefit of sharing video messages with others that does not require transmission of the full video along with the email.”

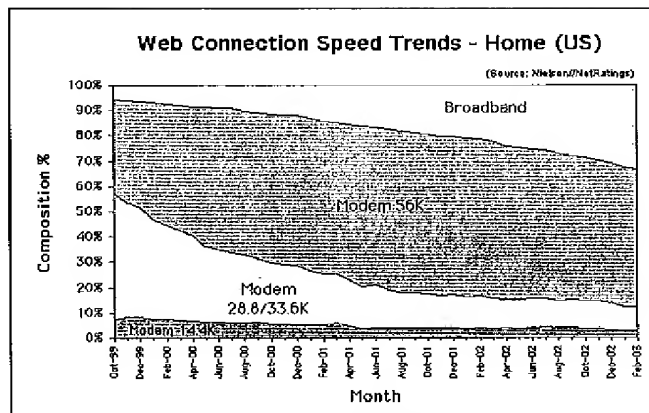
As discussed in the “Streaming Email” publication, the Video Express Email program *requires* installation of a video player by a recipient to be able to view a video transmitted by a user (i.e., the sender) of the Video Express Email program (*See* page 311, #5; page 313, FIG. 18.5; page 309, first paragraph); thus the sender is given the option to send the required player along with the video to the recipient. In contrast, the present invention does not require the use of a specialized viewer to be installed to view a transmitted video. When interpreting the patentability of a claim, the law requires that a reference be considered for all of its teachings, *including disclosure that diverges and teaches away from the invention at hand* as well as disclosures that point toward and teach the invention. (*In re Dow Chem. Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988)) (emphasis added). Accordingly, the teaching of the “Streaming Email” publication must also include the requirement that specialized software configured to view the received proprietary video file be transmitted to and be installed at a recipient’s end prior to allowing the recipient to view the video file. This is not the case in the present invention. Additionally, having an attached application be transmitted to a recipient of the email would go against the objective of minimizing the size of a file to be transmitted via email, which is one of the reasons why the video of the present invention is presented in a streaming video format (*See e.g.*, page 32, line 11 of specification). Furthermore, the video data in the Rothschild system is not indicated to be proprietary video, which would ordinarily require that specialized software be used to view it. In fact, the Rothschild publication makes no mention that the video is streaming, which according to the “Streaming Email” publication, would teach a person having ordinary skill in the art that a specialized player is required. Accordingly, the “Streaming Email” publication further teaches away from combining the streaming email aspect disclosed therein with those of ordinary video transmission disclosed in the Rothschild publication.

In the final Office Action, the Examiner cites *In re Van Geuns* with respect to Appellant’s aforementioned arguments relating to the specialized player being required to view the videos in the “Streaming Email” publication. Appellant’s argument was directed to show how the “Streaming Email” publication teaches away from the claimed subject matter, as opposed to differentiating the claimed subject matter from the “Streaming Email”

publication. Thus, application of the principles of *In re Van Geuns* has no bearing on Appellant's arguments.

Furthermore, the Examiner points to Appellant's argument relating to "having an attached application be transmitted to a recipient of the email would go against the objective of minimizing the size of a file to be transmitted via email, which is one of the reasons why the video of the present invention is presented in a streaming video format." In response, the Examiner asserts that the "Streaming Email" publication discloses: "To send messages faster, don't send the Video Express Email player or the actual downloadable multimedia file. These seriously slow down your transmission, especially with large files. Only send *downloadable* files if your recipient absolutely needs a copy for offline viewing" (emphasis added). This refers to the ability to send non-streaming videos (i.e., downloadable files) instead of the streaming videos "when the recipient would like to have a better quality, perhaps uncompressed, video file" (See first full paragraph on page 312 of "Streaming Email" publication). Thus, the "Streaming Email" publication recognizes that non-streaming video formats can be viewed without the specialized player, but that streaming videos require that the recipient also receive a specialized player to enable viewing of the streaming video. Accordingly, Appellant's teaching away argument with respect to the specialized player is still valid in view of the Examiner's argument.

The Examiner uses the "thumbnail" disclosure of the Sezan patent to attempt to anticipate the claimed thumbnail limitations and to attempt to render obvious this claimed subject matter in the overall context of independent claims 1 and 36. Appellant acknowledges that thumbnails are indeed taught in the Sezan patent, however, Appellant disagrees with the Examiner's asserted motivation to combine this teaching due to the teaching away aspect of the Sezan patent. Specifically, the Examiner states that modifying the methods of the Rothschild publication with those of the "Streaming Email" publication would be "for the benefit of assisting users in selecting video content for viewing..." However, it is clear that the reason for providing thumbnails in the Sezan system is actually to allow a user to easily differentiate between numerous possible video selections presented to them at one time (See e.g., FIGS. 4, 5 of the Sezan patent). In contrast, claim 36 specifically sets forth the transmission in the context of an email transmission. At the time of the invention, less than 10% of U.S. households having Internet-access were connected via a broadband connection.



(See <http://www.websiteoptimization.com/bw/0302>)

Thus, Internet users would be hesitant to attach one video, let alone more than one video as an email attachment. Even if more than one video were to be sent at the time of the invention, the thumbnail aspect would not be something that one having ordinary skill in the art would think of implementing in the email attachment context, since, due to the limited number of attachments (e.g., 1 or 2), it would not have been necessary to have thumbnails for content differentiation purposes (contrast with at least 20 videos shown to the user in FIGS. 4, 5 of the Sezan patent). Accordingly, it would not have been obvious to someone attempting to put together the claimed video sharing system in the context of email communications to implement the thumbnail teachings of the Sezan patent.

As shown in the Examiner's response in the final Office Action, the Examiner is now utilizing Appellant's cited benefit for supplanting his previous motivation for combination of the teachings of the references. However, Appellant's teaching away argument is still valid, as the benefit the Examiner relies upon would not have manifested itself at the time of the invention, as discussed above -- any application of this benefit is simply hindsight reconstruction and is incongruous with the technological limitations at the time of the invention.

(iii) Conclusion

The present invention is a novel and non-obvious method for sharing a video segment and an advertisement associated with that video segment over a network. The video segment is sent in a streaming format over the network along with the associated



advertisement to a receiving computer, so that both the video and the associated advertising segment may be viewed at the receiving computer.

In light of the aforementioned arguments made with respect to (i) the anticipation rejections under the Rothschild publication and/or the Sezan patent references, whose underlying anticipation teachings, are used for rejecting at least claims 1 and 36 on an obviousness basis in view of their teachings being combined with that of the "Streaming Email" publication, and (ii) the teaching away arguments with respect to the "Streaming Email" publication, Rothschild publication, and Sezan patent, Appellant hereby respectfully requests that the Examiner's improper obviousness rejection be reversed and Letters Patent be granted on the claimed subject matter.

### **VIII. CLAIMS APPENDIX**

A copy of the claims, as presently pending, is provided in the Claim Appendix attached hereto.

**IX. EVIDENCE APPENDIX**

None

Response Under 37 C.F.R. §41.67  
Amended Appellant's Brief  
Application No. 09/631,583  
Paper Dated: October 30, 2009  
Attorney Docket No. 5882-083847

**X. RELATED PROCEEDINGS APPENDIX**

None

### CONCLUSION

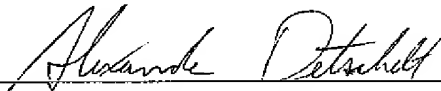
In view of the foregoing, it is respectfully submitted that the rejections of claims 1, 7, and 36 under 35 U.S.C. §103(a) are improper. Accordingly, the Appellant respectfully urges the Board to reverse the Examiner's final rejections of the claims and remand the application to the Examiner with an instruction that a Notice of Allowance be issued.

A payment for \$270.00 to cover the 37 C.F.R. § 41.20(b)(2) small entity fee for filing an Appeal Brief Under 37 C.F.R. § 41.37 accompanies this Appeal Brief. The Commissioner for Patents and Trademarks is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650.

Any questions regarding this submission should be directed to the Appellant's undersigned representative, who can be reached by telephone at 412-471-8815.

Respectfully submitted,

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**CLAIMS APPENDIX**

Claim 1 (Previously Presented): A method of sending a video segment and an associated advertisement over a computer network, comprising:

- (a) acquiring a video segment and a still image in the form of a thumbnail from a sender at a computer system;
- (b) acquiring one or more advertisements from one or more advertisers at the computer system;
- (c) offering to the sender an opportunity to indicate a selection of an advertisement of the one or more advertisements to be associated with the video segment;
- (d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment; and
- (e) directly in response to the indication accepted in step (d), automatically at the computer system:
  - (i) assuring that the video segment is in a streaming video format;
  - (ii) creating an identifier for the video segment, wherein the identifier includes the still image and a link to the video;
  - (iii) associating the video segment and the advertisement; and
  - (iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer.

Claim 2 (Original): The method of claim 1, wherein the step of offering to a sender an opportunity to indicate a selection of an advertisement of the one or more advertisements includes a criterion selectable by the sender.

Claim 3 (Original): The method of claim 2, wherein said criterion is one of a subject of the advertisement, a length of the advertisement, and a remuneration paid for selecting the advertisement.

Claim 4 (Previously Presented): The method of claim 2, wherein said criterion includes affirmatively leaving the selection to the determination of said computer system.

Claim 5 (Original): The method of claim 1, wherein the step of offering to a sender an opportunity to indicate a selection of an advertisement of the one or more advertisements includes a default selection to be made if the sender fails to indicate a selection.

Claim 6 (Original): The method of claim 5, wherein the default selection includes a substantially randomized selection of an advertisement.

Claim 7 (Previously Presented): A method of sending a video segment and an associated advertisement over a computer network, comprising:

- (a) uploading a video segment and a still image in the form of a thumbnail from a sender computer system to a server computer system;
- (b) selecting, using the sender computer system, an advertisement stored at the server computer system by an advertiser; and
- (c) transmitting from the sender computer to the server computer system an indication of the selected advertisement, the indication causing the server computer system automatically to:
  - (i) assure that the video segment is in a streaming video format;
  - (ii) create an identifier for the video segment, wherein the identifier includes the still image and a link to the video segment;
  - (iii) associate the video segment and the advertisement; and
  - (iv) send the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

Claim 8 (Original): The method of claim 7, wherein selecting an advertisement comprises selecting an advertisement using a criterion chosen by an operator of the sender computer system.

Claim 9 (Original): The method of claim 8, wherein said criterion is one of a subject of the advertisement, a length of the advertisement, and a remuneration paid for selecting said advertisement.

Claim 10 (Original): The method of claim 8, wherein said criterion includes leaving said selection to the determination of said server computer system.

Claim 11 (Original): The method of claim 10, wherein said selection includes a substantially randomized selection of an advertisement.

Claim 12 (Previously Presented): The method of claim 10, wherein said selection is based on a price paid by the advertiser.

Claims 13-35 (Cancelled)

Claim 36 (Previously Presented): A method for operating a video-sharing server on a network comprising:

- storing a plurality of advertisements from one or more advertisers;
- receiving from a client a video, a still image in the form of a thumbnail, an electronic mail address, and a selection of one of the plurality of advertisements;
- confirming that the video is in a streaming video format;
- storing the video at a network-accessible location;
- generating an identification tag including a link and the still image to the network accessible location;
- generating an electronic communication containing the identification tag and the selected one of the plurality of advertisements, the electronic communication addressed to the electronic mail address; and
- transmitting the electronic communication.

Claim 37 (Previously Presented): The method of claim 36 wherein receiving the video includes at least one of receiving an FTP upload, receiving an HTTP post, receiving an electronic mail, and receiving an instant message.

Claim 38 (Previously Presented): The method of claim 36 further comprising publishing the link to a Web page.



Claim 39 (Previously Presented): The method of claim 36 further comprising receiving a mailing list including a plurality of e-mail addresses and transmitting the electronic message to the plurality of e-mail addresses.

Claim 40 (Previously Presented): The method of claim 36 wherein the link includes one or more of a path, a URL, an IP address, and a file name.